

V. REMARKS

1. Claims 7 and 8 are amended. Claim 5 is cancelled without prejudice. The specification is amended.

2. The Examiner has objected to the specification as failing to provide proper antecedent basis for the claimed subject matter, in particular claim 5, and claim 10. Claim 5 has been cancelled.

With respect to claim 10, the Examiner has noted that the disclosure does not specifically disclose a "storage medium". The specification is amended to include the text of originally filed claim 10, as permitted by the MPEP. As such Applicant submits that the specification as originally filed does provide for support of the claimed subject matter of claim 10, when read by one skilled in the art.

3. The Examiner has rejected claim 10 under 35 U.S.C. 101 because it is directed towards a storage medium. The Examiner alleges that the lack of description of a "medium" does not limit the medium to a tangible embodiment, and could be interpreted to include such non-tangible media as wireless transmission media or an electro-magnetic signal. Applicant submits that the specification as amended and the claimed subject matter of a storage medium, and not simply a medium, limits the subject matter to a tangible embodiment, as would be understood by one skilled in the art. Therefore, this objection should be overcome.

4. The Examiner has rejected claim 5 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Claim 5 has been cancelled.

5. The Examiner has rejected claim 8 under 35 U.S.C. 112, second paragraph as being indefinite, for incorrectly depending on a system claim. Applicant thanks the Examiner for interpreting the claim as depending on claim 7. Claim 8 has been amended to depend on claim 7.

6. The Examiner has rejected claims 1, 2 and 7-9 under 35 U.S.C. 102(b) as being anticipated by US Patent Application Publication No. US 2002/0073094 by Becker et al. (hereinafter "Becker")

The system and method taught by the current application is directed towards the process control programming of machine automation systems. It teaches that an automated application is generally comprised of three major elements, including the configuration of the automated machine, the configuration of the product type, and a machine automation procedure. The system and method as claimed in the independent claims, and described in the specification as originally filed allows for the separation of each of the major elements. By separating the system configuration, product configuration and machine automation procedure, each one may be easily changed. Examples of the benefits of such a system and method are described in the description as originally filed. In particular it describes that a minor step module can be created for a motion routine based on any local coordinate frame. The system configuration manager will then independently define how this minor step module fits into any given machine.

The system and method taught by Becker discloses a way of reusing already created automation solutions in engineering. The system and method allows for the aggregating of a set of automation objects on an ad-hoc basis to form a new set. Becker teaches combining groups of automation objects together and then presenting them as new automation objects or compounds. These compounds contain modules for: system functionality; generic basic functionality; interconnection of the compound

with other automation objects; parameterization of the compound with other automation objects; and automation object management. The teachings of Becker appear to be directed towards aggregating automated objects into compounds, which may be used as automated objects in an engineering automation solution plan.

The disclosure of Becker does not teach or suggest any of the features of the current claims. In particular, Becker fails to disclose at least the system configuration manager for defining machine configuration independent of said minor step modules. Becker fails to suggest specifying a machine configuration independent of the minor step modules. The Examiner has alleged that the interconnection module disclosed by Becker teaches the system configuration manager. This is not correct. As recited and claimed by Applicant, the system configuration manager defines the machine parameters that enable separation of machine geometry from process creation (see e.g. page 13, lines 28-30) when a minor step module can be created for a motion routine and the system configuration manager will independently define how the minor step module fits into a given machine (see e.g. page 14, lines 1-3). The disclosure of Becker teaches that the interconnection module allows interconnection of the compound or automation module with other automation objects. The interconnection module is derived from the cut-off interconnections, which are interconnections cut-off during creation of the new model. (See e.g. paragraphs [0025 and 0026].) This does not suggest defining the machine configuration independent of minor step modules, as required by the current claims, and in particular independent claim 1.

With respect to claim 2, the Examiner has further alleged that Becker discloses that the procedures can further include major step modules assembled from a plurality of said minor step modules to perform a larger machine function. The section cited by the Examiner does not teach or suggest this limitation. It describes that automation objects may themselves be compounds. Becker fails to teach the specific limitation of claim 2, as well as failing to teach or suggest the features of independent claim 1 which claim 2

depends. As such, Applicant submits that claim 2 contains patentable subject matter over Becker.

With respect to claim 7, the Examiner has further alleged that Becker discloses a modular method for programming machine automation controls. Applicant submits that the sections cited by the Examiner do not teach such a method. Becker teaches a method of connecting automation objects or compounds within an automation plan to create new compounds. These compounds cannot be considered equivalent to the minor step modules. The Examiner has alleged that all further limitations have been addressed in the rejection of claim 1. Applicant submits that Becker fails to disclose the limitations of independent claim 7, for similar reasons as outlined for claim 1. As such, Applicant submits that claim 7 contains patentable subject matter over Becker.

With regard to claim 8, the Examiner has cited similar arguments as those presented for rejecting claim 2. As such, Applicant submits that claim 8 contains patentable subject matter over Becker for similar reasons as outlined for claim 2.

With respect to claim 9, the Examiner has rejected the claim on the same grounds as for the rejection of claim 1. Applicant submits that Becker fails to disclose the limitations of independent claim 9, for similar reasons as outlined for claim 1. As such, Applicant submits that claim 9 contains patentable subject matter over Becker.

Applicant submits that current claims 1, 2 and 7 – 9 contain patentable subject matter over Becker as outlined above, and as such comply with 35 U.S.C. 102(b) with respect to Becker.

7. The Examiner has rejected claims 3 and 4 under 35 U.S.C. 103(a) as being unpatentable over Becker in view of Meyer. As outlined above for independent claim 1, on which claims 3 and 4 depend, either directly or indirectly, Becker fails to teach the

system as claimed, and understood in light of the specification as originally filed. Meyer fails to disclose any information that one skilled in the art could apply to the teachings of Becker to arrive at the claimed subject matter of independent claim 1. As such, Applicant submits that claims 3 and 4, which depend on claim 1, also contain patentable subject matter over Becker in view of Meyer.

It is also submitted that there is no motivation to combine Becker with Meyer for purposes of 35 U.S.C. §103(a). The Examiner states that it would be obvious to combine Meyer with Becker since Becker's components provide fundamental programming concepts without requiring standard software programming code. However, what the Examiner has not shown is why one of the skill in the art, when confronted with the same problem addressed by Applicant, would choose to select elements from Meyer to combine with Becker to address this problem. See In re Rouffet, 47 USPQ2d 1453, 1457-1458 (Fed. Cir. 1998).

While the Examiner may refer to advantages of the proposed combination, this is not the same as motivation to combine references to arrive at an invention. The Examiner must refer to motivation to combine specific features to address the problem solved by Applicant's claims. See e.g. Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc., 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). In the absence of any such showing, a *prima facie* case of obviousness is not established.

The Examiner has rejected claim 5 under 35 U.S.C. 103(a) as being unpatentable over Becker in view of Meyer. Claim 5 has been cancelled.

The Examiner has rejected claims 6 and 10 under 35 U.S.C. 103(a) as being unpatentable over Becker in view of Detlefs. Claim 10 contains all of the limitations of independent claim 1. As outlined above for independent claim 1, on which claim 6 depends, Becker fails to teach the system as claimed, and understood in light of the

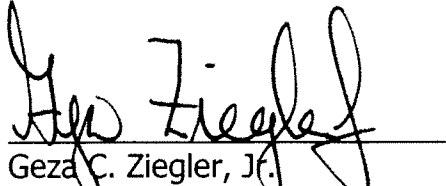
specification as originally filed. Detlefs fails to disclose any information that one skilled in the art could apply to the teachings of Becker to arrive at the claimed subject matter of independent claim 1. Also, Applicant also submits that the Examiner has not provided the requisite showing of motivation as required for purposes of 35 U.S.C. §103(a). To "improve performance" is merely a possible advantage. It does not demonstrate or let alone establish, why one of the skill in the art, when confronted with the problem addressed by Applicant, would select elements from Detlefs to combine with Becker to solve the same problem. Further, what performance is being improved? Conceivably, any reference might be combined with Becker to improve performance. Applicant's claims address a specific problem. The Examiner should show why one would look to combine features of Detlefs and Becker to address the same problem. In the absence of any such showing, a *prima facie* case of obviousness under 35 U.S.C. §103(a) cannot be established. As such, Applicant submits that claims 6 and 10 contain patentable subject matter over Becker in view of Meyer.

In view of the amendments, remarks and having dealt with all of the objections raised by the Examiner, reconsideration and allowance is courteously requested.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge \$120.00 for a one-month extension fee along with any other fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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